



23 SEP 2008

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In re Application of SUN et al :
U.S. Application No.: 10/593,908 :
PCT Application No.: PCT/CN2005/000387 :
Int. Filing Date: 28 March 2005 : DECISION
Priority Date Claimed: 26 March 2004 :
Attorney Docket No.: 514572002800 :
For: METHODS AND BIOCHIPS FOR :
DETECTING SMALL MOLECULE COMPOUNDS :

This is in response to the correspondence filed 06 September 2007, which is being treated as a petition under 37 CFR 1.497(d).

BACKGROUND

On 28 March 2005, applicant filed international application PCT/CN2005/000387, which claimed priority of an earlier China application filed 26 March 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 06 October 2005. The thirty-month period for paying the basic national fee in the United States expired on 26 September 2006.

On 22 September 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 06 June 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 06 September 2007, applicant filed an executed declaration along with the present petition under 37 CFR 1.497(d).

DISCUSSION

The present petition requests that Yuan Chen be removed as an inventor and that Yuan Lu be added as an inventor.

37 CFR 1.497(d) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

With regard to item (1) above, the requisite statement from Yuan Chen has not been provided.

With regard to item (2) above, the requisite processing fee will be charged to Deposit Account No. 03-1952.

With regard to item (3) above, MPEP 201.03, Section II. D., states in relevant part, "Where no assignee exists requester should affirmatively state that fact. If the file record including the request is silent as to the existence of an assignee it will be presumed that no assignee exists. Such presumption should be set forth in the decision to alert requesters to the requirement." In the present case, the petition fails to affirmatively state that the application has not been assigned by any of the original named inventors, and it is presumed that no assignee exists.

With regard to item (4) above, a new declaration under 37 CFR 1.497(f) is not required.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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